

Remarks

Claims 1-4, 6, 9-19, 28 and 29 are pending in the application with claims 1, 12, 16, 28 and 29 being independent.

Claims 1, 2, 6, 9-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz (U.S. Patent Application Publication No. 2002/0065800 A1, hereinafter "Morlitz") in view of Pepper et al. (U.S. Patent No. 7,206,777 B2, hereinafter "Pepper") and further in view of Hall, III et al. (U.S. Patent Publication #7,870,089 B1, hereinafter "Hall").

Claims 3, 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Pepper and further in view of Hall and further in view of Shanman et al. (U.S. Patent No. 7,231,357 B1, hereinafter "Shanman").

Claims 28 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morlitz in view of Hall.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent

form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Objection to the Specification

In the Office Action, the specification is objected to due to a typographical error.

Applicants have herein amended the specification to correct the typographical error.

The Examiner is respectfully requested to withdraw the objection.

Rejection Under 35 U.S.C. 103

Claims 1, 2, 6, 9-16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Pepper and further in view of Hall. The rejection is traversed.

The Office Action fails to establish a *prima facie* case of obviousness of Applicants' independent claim 1, because the portions of Hall cited in the Office Action as disclosing certain features of Applicants' independent claim 1 fail to teach or suggest the features asserted to be disclosed.

In the Office Action, the Examiner cites specific portions of Hall (namely, FIGs. 1 and 3 and Col. 6, Line 61 – Col. 7, Line 33), asserting that the cited portions of Hall disclose the feature of "wherein the resource index file includes a link listing comprising a plurality of links to the embedded data, wherein the link listing is arranged in an order of pre-determined times to obtain the embedded data." Applicants disagree.

The cited portion of Hall merely states that digital signatures may be stored as an array of values, an index, a dynamic list, or other information and that "[t]he digital signatures may be sorted or organized for faster comparisons." (See Hall, Col. 6, Lines 65

– 66). It is noted that the “comparison” referenced in this portion of Hall is a comparison of a digital signature of a received embedded digital resource against the stored digital signatures of digital resources accessible to the receiving system for determining whether or not the received embedded digital resource is already stored. (See Hall, Abstract). A statement that digital signatures are organized for faster comparisons, as disclosed in Hall, does not teach or suggest that the digital signatures (assuming *arguendo* that the digital signatures of Hall could be interpreted as disclosing the links of Applicants’ claim 1) are “arranged in an order of pre-determined times to obtain the embedded data,” as recited in Applicants’ claim 1. The cited portions of Hall are devoid of any teaching or suggestion that digital signatures are arranged in an order of pre-determined times to obtain the embedded digital resources and, thus, even assuming *arguendo* that the digital signatures of Hall could be interpreted as disclosing the links of Applicants’ claim 1, the cited portions of Hall still would fail to teach or suggest the feature of “wherein the resource index file includes a link listing comprising a plurality of links to the embedded data, wherein the link listing is arranged in an order of pre-determined times to obtain the embedded data.”

As such, independent claim 1 is allowable over Morlitz, Pepper and Hall under 35 U.S.C. 103(a). Similarly, independent claims 12 and 16 recite relevant limitations similar to those recited in independent claim 1. As such, for at least the same reasons discussed above, independent claims 12 and 16 also are allowable over Morlitz, Pepper and Hall under 35 U.S.C. 103(a). Furthermore, since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim also is allowable over Morlitz, Pepper and Hall under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.

Claims 3, 4, 17

Claims 3, 4, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Pepper and further in view of Hall and further in view of Shanman. The rejection is traversed.

Each of these grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection of independent claims 1 and 16 under 35 U.S.C. 103(a) over Morlitz, Pepper and Hall. Since such rejection has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Shanman supplies that which is missing from Morlitz, Pepper and Hall to render independent claims 1 and 16 obvious, these grounds of rejection cannot be maintained.

As such, Applicants' claims 3, 4 and 17 are allowable over Morlitz in view of Pepper and further in view of Hall and further in view of Shanman under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.

Claims 28 and 29

Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morlitz in view of Hall. The rejection is traversed

The Office Action fails to establish a *prima facie* case of obviousness of Applicants' independent claim 28, because the portions of Hall cited in the Office Action as disclosing certain features of Applicants' independent claim 28 fail to teach or suggest the features asserted to be disclosed.

In the Office Action, the Examiner cites specific portions of Hall (namely, Col. 5, Line 55 – Col. 6, Line 22 and Col. 8, Line 63 – Col. 9, Line 11), asserting that the cited portions of Hall disclose the feature of “suppress, at the client device, initiation of requests for the embedded data associated with the identifiers of the embedded data.” Applicants disagree.

The first portion of Hall cited in the Office Action discloses that as messages with a famous photograph are repeatedly exchanged, subsequent recipients may be given a link to a previously stored version of the famous photograph rather than storing an additional instance of the photograph. This portion of Hall states that “[f]or example, the first five instances may be stored, while the next 1000 messages with that embedded image might be given a link to one of the five stored instances of the resource.” (See Hall, Col. 6, Lines 6 – 8, Emphasis added). This portion of Hall further indicates that “...the link to the attached or embedded resource includes the address at which the famous photo may be accessed...[t]hus, providing a user with the link comprises providing the user

with an address for a previously-stored instance of the digital resource." (See Hall, Col. 6, Lines 12 – 16, Emphasis added). In other words, from the cited portions of Hall, it is clear that the user which is provided with a link to a previously stored version of the resource is given an address at which the resource may be accessed, such that the user may initiate a request to retrieve the resource from the address from which the resource may be accessed. Thus, not only does the cited portion of Hall fail to teach or suggest the feature of "suppress, at the client device, initiation of requests for the embedded data associated with the identifiers of the embedded data," the cited portion of Hall actually teaches away from "suppress, at the client device, initiation of requests for the embedded data associated with the identifiers of the embedded data," because the cited portion of Hall requires that the user initiate a request to retrieve the resource from the address from which the resource may be accessed.

The second portion of Hall cited in the Office Action, similar to the first portion of Hall discussed above, merely discloses that "...if the digital signature is found among the stored digital signatures (step 320), the resource associated with a received resource or message is replaced with a location identifier or pointer to the stored instance of the resource to avoid duplication while enabling future access to the received resource." (See Hall, Col. 8, Line 63 – Col. 9, Line 1, Emphasis added). In other words, as with the first portion of Hall discussed above, it is clear that the location or pointer enables access to the received resource, such that a user may use the location or pointer to initiate a request to retrieve the resource. Thus, as with the first portion of Hall discussed above, not only does the cited portion of Hall fail to teach or suggest the feature of "suppress, at the client device, initiation of requests for the embedded data associated with the identifiers of the embedded data," the cited portion of Hall actually teaches away from "suppress, at the client device, initiation of requests for the embedded data associated with the identifiers of the embedded data," because the cited portion of Hall requires that the user initiate a request to retrieve the resource.

As such, independent claims 28 and 29 are allowable over Morlitz and Hall under 35 U.S.C. 103(a). The Examiner is respectfully requested to withdraw the rejection.


Conclusion

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 542-2280 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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